

10/821,503 filed 04/08/2004

J. Wallace Parce, et al.

Reply to Office Action of September 29, 2005

### REMARKS/ARGUMENTS

Claims 2-26 are pending in the above-captioned application. Of these claims, claims 2-5, 7-9, 11-20, 24, and 25 were rejected, and claims 6, 10, 21-23, and 26 were objected to as being dependent upon a rejected base claim. With this paper, claims 2, 6, 19, 21, and 26 have been amended; and claims 10 and 18 have been canceled. No new matter was added with the amendment.

#### I. Specification

The disclosure was objected to because of the informality that the status of a parent application cited on page 1 of the application needed to be updated. The appropriate correction has been made.

#### II. Double patenting

Claims 2, 3, 9, 11, 12, 16, 18-20, 24, and 25 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 7, 22, 31, 43, 44, and 47 of U.S. Patent No. 5,942,443. This rejection is respectfully traversed.

Independent claim 2 has been amended with this paper to include the limitations of claim 10, which was determined by the Examiner to be allowable if rewritten in independent form. Applicants respectfully submit that claim 2 is thereby placed in condition for allowance over U.S. Patent No. 5,942,443. Claims 3, 9, 11, 12, 16, 24, and 25 depend directly or indirectly from claim 2. Applicants respectfully submit that these dependent claims are now also in condition for allowance over U.S. Patent No. 5,942,443.

Claim 21 was determined by the Examiner to be allowable if rewritten in independent form to include all of the limitations of the base claim (claim 2) and intervening claim 18. This has been done, with claim 18 being canceled as a result. Claims 19 and 20 now depend directly or indirectly from claim 21. Applicants respectfully submit that these dependent claims are now in condition for allowance over U.S. Patent No. 5,942,443.

Therefore, withdrawal of the rejection of claims 2, 3, 9, 11, 12, 16, 19, 20, 24, and 25 under the judicially created doctrine of obviousness-type double patenting is respectfully requested.

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#### I. Specification

The disclosure was objected to because of the informality that the status of a parent application cited on page 1 of the application needed to be updated. The appropriate correction has been made.

#### II. Double patenting

Claims 2, 3, 9, 11, 12, 16, 18-20, 24, and 25 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 7, 22, 31, 43, 44, and 47 of U.S. Patent No. 5,942,443. This rejection is respectfully traversed.

Independent claim 2 has been amended with this paper to include the limitations of claim 10, which was determined by the Examiner to be allowable if rewritten in independent form. Applicants respectfully submit that claim 2 is thereby placed in condition for allowance over U.S. Patent No. 5,942,443. Claims 3, 9, 11, 12, 16, 24, and 25 depend directly or indirectly from claim 2. Applicants respectfully submit that these dependent claims are now also in condition for allowance over U.S. Patent No. 5,942,443.

Claim 21 was determined by the Examiner to be allowable if rewritten in independent form to include all of the limitations of the base claim (claim 2) and intervening claim 18. This has been done, with claim 18 being canceled as a result. Claims 19 and 20 now depend directly or indirectly from claim 21. Applicants respectfully submit that these dependent claims are now in condition for allowance over U.S. Patent No. 5,942,443.

Therefore, withdrawal of the rejection of claims 2, 3, 9, 11, 12, 16, 19, 20, 24, and 25 under the judicially created doctrine of obviousness-type double patenting is respectfully requested.

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III. Claim rejections under 35 U.S.C. § 102(e) as being anticipated by Kricka et al. (US 5,744,366)

Claims 2-5, 7-9, 11, 12, 16-20, 24, and 25 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Kricka et al. (US 5,744,366). This rejection is respectfully traversed. "[F]or anticipation under 35 U.S.C. § 102, a single reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present." MPEP § 706.02. "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, USPQ2d 1913, 1920 (Fed. Cir. 1989).

As previously noted, independent claim 2 has been amended to include the limitations of claim 10, which limitations are not taught by Kricka et al. Withdrawal of the rejection of amended independent claim 2 under U.S.C. § 102(e) as being anticipated by Kricka et al. is, therefore, respectfully requested.

Claims 3-5, 7-9, 11, 12, 16, 17, 24, and 25 depend directly or indirectly from amended independent claim 2. Therefore, Applicants respectfully submit that these dependent claims are allowable for at least the same reasons as set forth herein with respect to amended independent claim 2. Withdrawal of the rejection of dependent claims 3-5, 7-9, 11, 12, 16, 17, 24, and 25 under U.S.C. § 102(e) as being anticipated by Kricka et al. is respectfully requested.

Claims 19 and 20 now depend directly or indirectly from claim 21, which, as previously noted, has been rewritten in independent form to include all of the limitations of base claim 2 and intervening claim 18. Claim 21 was determined by the Examiner to be allowable if rewritten in this manner. Applicants respectfully submit that claims 19 and 20 are allowable for at least the same reasons as set forth herein with respect to the amended and now independent claim 21. Therefore, withdrawal of the rejection of dependent claims 19 and 20 under U.S.C. § 102(e) as being anticipated by Kricka et al. is respectfully requested. As previously noted, claim 18 has been canceled.

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IV. Claim rejections under 35 U.S.C. § 103(a) as being unpatentable over Kricka et al. (US 5,744,366) in view of Wilding et al. (US 5,637,469)

Claims 13–15 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kricka et al. (US 5,744,366) in view of Wilding et al. (US 5,637,469). The rejection of these claims is respectfully traversed.

To warrant rejection under 35 U.S.C. § 103(a), all the claim limitations must be taught or suggested by the prior art. See MPEP § 2142. Claims 13–15 depend directly or indirectly from amended independent claim 2, which, as has been described above, now includes the limitations of claim 10. The limitations of claim 10 are not taught either by Kricka et al. or by Wilding et al. Therefore, amended independent claim 2 is nonobvious. Any claim depending from a nonobvious claim is also nonobvious. See MPEP § 2143.03 and *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Thus, dependent claims 13–15 are nonobvious. Withdrawal of the rejection of these claims as being unpatentable over Kricka et al. in view of Wilding et al. is, therefore, respectfully requested.

V. Allowable subject matter

Claims 6, 10, 21–23, and 26 were objected to as being dependent upon a rejected base claim but were determined to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 6 has been rewritten in independent form to include the limitations of base claim 2, rendering claim 6 allowable. No claims intervened between claim 6 and claim 2.

The limitations of claim 10 have been incorporated into base claim 2, thereby rendering claim 2 allowable. No claims intervened between claim 10 and claim 2.

Claim 21 has been rewritten in independent form to include the limitations of base claim 2 and intervening claim 18. Claims 22 and 23 remain dependent upon claim 21.

The limitation of claim 26 is a member of the Markush group of the currently amended independent claim 2. For this reason, claim 26 has not been rewritten in independent form. Claim 26 has, however, been amended to depend from amended claim 21. Prior to this amendment, claim 26 indicated dependency upon claim 1, which had been previously canceled by the preliminary amendment mailed April 8, 2004.

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Applicants wish to point out that claim 2 has also been amended to replace the phrase "the device" with the phrase "an analytical device fabricated in a planar substrate." Support for the amendment can be found, for example, on page 22, lines 17 and 18. The same change of phrase is also present in amended claims 6 and 21.

Conclusion

For the foregoing reasons, Applicants believe all the pending claims are in condition for allowance and should be passed to issue. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned attorney.

Respectfully submitted,



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Signed: \_\_\_\_\_

